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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,500	11/21/2003	Joseph Chappell	8064-005-CIP-2	8924
32301 7590 02/06/2009 CATALYST LAW GROUP, APC 9710 SCRANTON ROAD, SUITE S-170 SAN DIEGO, CA 92121				
EXAMINER				
KALLIS, RUSSELL				
ART UNIT		PAPER NUMBER		
1638				
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02/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/717,500

Applicant(s)

CHAPPELL ET AL.

Examiner

RUSSELL KALLIS

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10-21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Russell Kallis/
Primary Examiner, Art Unit 1638

Continuation of 11, does NOT place the application in condition for allowance because: Claims 10-21 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **THIS IS A NEW MATTER REJECTION.** This rejection is maintained for the reasons of record set forth in the Official action mailed 3/06/2008 and 9/30/2008. Applicant's arguments filed 12/30/2008 have been considered but are not deemed persuasive.

Applicant argues that page 15 lines 1-12 and the drawings specifically in figure 5 provide the support for "more than one isoprenoid reaction product in a ratio differing from the ratio of the products produced in the absence of the second isoprenoid synthase polypeptide". However, Applicant fails to acknowledge that those portions of the specification point to a third domain as being the ratio determining domain and that is illustrated in figure 5. A more clear illustration of this domain is to be found in Figure 4A CH11 to CH14 where the XbaI to HincII restriction sites define the boundaries of this ratio determining domain with respect to the first isoprenoid polypeptide and the second isoprenoid polypeptide. So, there is no interpretive support or 'support by rephrasing' in the specification for "more than one isoprenoid reaction product in a ratio differing from the ratio of the products produced in the absence of the second isoprenoid synthase polypeptide" as argued on page 7 of Applicants' response because either the first of the second polypeptide will determine the ratio of products in the presence of the other domain. That is to say the ratio is determined by whichever polypeptide comprises the XbaI to HincII region. Further, there are no different products produced in the absence of the second domain (i.e. there is not more than one reaction product produced in the absence of the second domain) and thus there is no ratio of products produced in the absence of the second domain. Again see Figure 4A where in the absence of the second domain there is 100% product produced; and thus there is no support by rephrasing as argued on page 7 of the response. Therefore given the lack of literal support for "more than one isoprenoid reaction product in a ratio differing from the ratio of the products produced in the absence of the second isoprenoid synthase polypeptide" and given the lack of interpretive support or support by rephrasing the claims are drawn to NEW MATTER.

Claims 10-21 remain rejected under 35 U.S.C. 112, first paragraph, written description and enablement. This rejection is maintained for the reasons of record set forth in the Official action mailed 3/06/2008 and 9/30/2008. Applicants' arguments filed 12/30/2008 are largely duplicative of those previously filed and addressed in the previous office action or addressed supra.